

RESPONSE

Claims 31-34 are pending in this application. The Examiner has rejected claims 2 and 4-31 under the judicially created doctrine of double patenting as being unpatentable over claims 1, 2 and 5-18 of U.S. Patent No. 6,531,537 B2 (Friel) in view of U.S. Patent Number 6,330,487 (Jahn).

Obviousness-type Double Patenting Rejection Over Friel in view of Jahn

The Examiner rejected claims 2 and 4-31 under the obviousness-type double patenting doctrine, over Friel, in view of Jahn, asserting that the dispensation of ingredients at a retail purchase point of sale in the manner disclosed by Jahn is admitted prior art, and one of ordinary skill in the art would know to modify Friel's invention to include Jahn's distributed computer system. Applicants respectfully traverse because Jahn's dispensation method is not admitted prior art.

In Applicants' response to the October 6, 2003 Office Action, Applicants neglected to address a matter Applicants believed was fairly minor, namely, the Examiner's brief statement that "it is well known in the manufacturing business art to provide dispenses [sic] with ingredients at a retail purchase point of sale based upon specification by a retail customer and the Examiner takes Official Notice as such." Obviously, Applicants' argument against the obviousness rejection based on Jahn and Cane was predicated on the basic fact that those references did not disclose Applicants' invention; and were improper to combine in any event. As such, it was unnecessary to address the Examiner's Official Notice. However, now that in the most recent Office Action the Examiner desires to make that Official Notice as "admitted prior art," Applicants take exception.

Firstly, MPEP 2144.03 specifically states that taking Official Notice is supposed to happen only rarely. It also expressly warns:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. (citations omitted)

As is well known in the law, one aspect of an obviousness rejection is that the differences in question, taken in combination with the claim as a whole, be obvious to *one skilled in the relevant art*. In Applicants' case, the claims, and the relevant art, are directed to paint, and the Examiner has failed to note any particular teaching in that art, or any analogous art to support her Official Notice. In that regard, the facts alleged in the Official Notice in this case are "not capable of instant and unquestionable demonstration." Therefore, it was improper to take such Notice in these circumstances, in the first instance, and more improper later to make the fact that Applicants did not address that Notice (because Applicants did not need, and were not required to), and turn that into "admitted prior art." Applicants object to this procedure, and simply want to make the record of this prosecution reflect that. Accordingly, Applicants disagree with any notion that Applicants have admitted that kind of subject matter to be prior art relevant to this case.

In light of the above, Applicants respectfully submit that the obviousness type double patenting rejection is improper. Notwithstanding the above, Applicants have filed a terminal disclaimer in compliance with 37 C.F.R. 1.321(c), solely for the purpose of expediting prosecution. The terminal disclaimer is not an admission by Applicants that Applicants present claims are obvious over claims 1, 2 and 5-18 of Friel, in view of Jahn.

Conclusion

In view of the foregoing, Applicants respectfully request the Examiner to allow the claims, as amended.

This Amendment and Response is filed by the undersigned registered patent attorney pursuant to 37 C.F.R. 1.34(a). It is requested that all correspondence with respect to this application be directed to the undersigned at the address noted below.

Respectfully submitted,



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